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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/306,006	05/06/1999	ANDREAS WERNER SUPERSAXO	NB/2-21551/A	2914

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EXAMINER

SHARAREH, SHAHNAM J

ART UNIT PAPER NUMBER

1617

DATE MAILED: 10/18/2002

25

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/306,006

Applicant(s)

SUPERSAXO ET AL.

Examiner

Shahnam Sharareh

Art Unit

1617

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 26 September 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 26 September 2002. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 2, 6, 10, 15-21, 24, 28-29.

Claim(s) withdrawn from consideration: _____

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s): _____
10. ☐ Other: _____

RUSSELL TRAVERS
PRIMARY EXAMINER
GROUP 1200

Continuation of 5. does NOT place the application in condition for allowance because: of the reasons of record. Applicants first argue that Yiv's compositions are limited to non-topical application. In response, Examiner states that such argument is not commensurate with the scope of the claims, as the instant claims are not limited to topical formulations. In fact, the instant claim 16 is directed to injectable solutions, and within the teachings of Yiv. Applicant further argues that Wo 96/37192 does not teach that ethanol is an essential component of their composition. Applicant further argues that the obviousness rejection is based on improper hindsight. In response to such arguments Examiner states that for setting forth a prima facie obviousness, one factor to be considered is the general knowledge in the art. In the instant case, both cited references teach compositions in the field of pharmaceutical formulations which includes parenteral (injectable) formulations. Accordingly, the teachings of cited art are in the same field of endeavour. Further, The WO patent clearly suggests the use of ethanol in such formulations as a carrier (see for example page 17, element d). Accordingly, combination of knowledge within the same field of endeavour indicating that ethanol can be readily used in similar pharmaceutical composition is not improper hindsight, rather prima facie obviousness. Finally, for the purposes of applying prior art absent a clear indication in the specification or claims of what the basic and novel characteristics actually are "consisting essentially of" will be construed as equivalent to "comprising." PPG Industries v. Guardian Industries, 156 F.3d 1351, 1355; MPEP 2111.03. Accordingly, Applicant's arguments stating "propylene glycol/polyethylene glycol component of Yiv is essential for Yiv," is not persuasive, because as in PPG, no positive teachings exclude such limitation in the instant claims.